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09/449,699	11/24/1999	KATSUNORI TSUTSUMI	990723/LH	6591

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EXAMINER

BIENEMAN, CHARLES A

ART UNIT PAPER NUMBER

2176

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/449,699

Applicant(s)

TSUTSUMI ET AL.

Examiner

Charles A. Bieneman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 November 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1448) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. This action is responsive to the following communications: original application, priority papers, and preliminary amendment, all filed on November 24, 1999.
2. Claims 1-11 are pending. Claims 1 and 11 are independent claims.

#### *Priority*

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1-11** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims appear to be a literal translation into English from a foreign document and are replete with idiomatic errors. These errors make it impossible for one reading the claims to be certain of their intended meaning and scope. The examples given below with respect to claims 1 and 11 are not intended to be exhaustive of the vague and indefinite recitations in claims 1-11.

Regarding **independent claims 1 and 11**, the limitation "to be outputted every page" in lines 4-5 of claim 1 and line 5 of claim 11 is not idiomatic English and it is unclear what subject matter applicants intend to be embodied in this limitation.

Further, the term "desirable" in claims 1 and 11 is a relative term which renders the claim indefinite. The term "desirable" is not defined by the claim, the specification does not provide a

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standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Further, the limitation "setting an output condition when each of said designated output-subject document data is outputted" in lines 10-12 of claim 1 and 10-12 of claim 11 does not make sense inasmuch as it appears that applicants are reciting setting a condition at the same time as, or after, the event that triggers the condition.

Further, the phrase "designated/set" in line 15 of claim 1 and line 16 of claim 11 is vague and indefinite because it is unclear whether applicants intend to claim designated contents, set contents, or both.

The dependent claims not mentioned above are rejected for fully incorporating the deficiencies of their base claims.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-4 and 11** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent Number 6,327,599 B1 to Warmus et al., issued December 4, 2001, filed June 7, 1995.

Regarding **independent claims 1 and 11**, Warmus et al. teach converting means for converting a plurality of documents formed by an application program into page document data to be outputted every page and storage means for SPOOL-storing each of the page document

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data converted by the converting means. (Warmus et al., col. 5, lines 41-48: "The master and variable page files and the press command file are converted by a collator and raster image processor (RIP) into bitmaps which may be stored in a memory. The stored bitmaps are used to control one or more demand printers and/or any other type of display device, such as a laser printer, a CRT, an LCD display or the like so that the device displays pages having fixed and variable information thereon.")

Further, Warmus et al. teach output-subject setting means for designating desirable page document data as output-subject document data SPOOL-stored in said storage means (Warmus et al., col. 8, lines 9-12: "A database 108 is also developed by the publisher using the personal computer 54 specifying the content of variable information to be placed in variable information areas, for example, the areas 110, 112 on the pages P1, P4, respectively, of FIGS. 6a and 6b."), and for setting an output condition when each of said designated output-subject document data is outputted. (Warmus et al., col. 9, lines 57-59: "Following the block 158, a block 160 prompts the user to enter an indication of whether the image object is to be displayed in one of two display formats.")

Further, Warmus et al. teach output control means for outputting page document data designated from the respective page document data SPOOL-stored in the storage means based on the contents designated/set by the output-subject setting means in accordance with said output condition. (Warmus et al., col. 8, line 57 – col. 9, line3: "The files 130, 132 are then converted into variable page files 134, 136. The files 134, 136 are identical to the files 130, 132, respectively, except that the data in each file identifying entries in the database are replaced by the actual data stored at such entries. . . . The print system 79 operates in response to the press

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commands in a press command file 140 and merges the page files 122, 137 and 138 (if no imposition is to be effected) or merges the page files 124 and 139 (if the pages are imposed) to create the finished books or book versions.”)

Regarding **dependent claim 2**, Warmus et al. teach that the output-subject setting means sets a sequence when the respective page document data are outputted as the output condition when each of the designated output-subject document data is outputted. (Warmus et al., col. 6, lines 5-9: “The variable information may be stored in a database created by the publisher and the template file(s) specify the locations on particular pages for variable information stored in the database as noted in greater detail hereinafter.”)

Regarding **dependent claim 3**, Warmus et al. teach converting the documents formed by the respective plural applications programs into page document data in a combined data format. (Warmus et al., col. 5, lines 48-52: “Alternatively, the master and variable page files may be premerged to create a plurality of combined files each representing a page to be reproduced with master and variable information.”; see also col. 6, lines 21-24: “The combined files may be printed or may alternatively be reproducible in a different medium and/or may comprise a non-static image or other information, i.e., movies or audio.”)

Regarding **dependent claim 4**, Warmus et al. teach output-subject setting means forming a virtual document file and setting both designation information and an output condition inasmuch as Warmus et al. teach a bitmap equivalent to a virtual document file (Warmus et al., col. 5, lines 41-43) that would have inherently included designation information (*i.e.*, what was included in the file) and an output condition (*i.e.*, the format and order in which content was outputted).

Further, Warmus et al. teach outputting page document data in accordance with the output condition, and the outputted page document data is designated from the respective page document data SPOOL stored in the storage means based upon the content which is set by the output-subject setting means as the storage information in the virtual document file. (Warmus et al., col. 5, lines 43-47: "The stored bitmaps are used to control one or more demand printers and/or any other type of display device, such as a laser printer, a CRT, an LCD display or the like so that the device displays pages having fixed and variable information thereon.")

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus et al. in view of U.S. Patent Number 5,88,103 to Aoyagi, issued December 24, 1996.

Warmus et al. do not teach output-subject setting means arbitrarily setting a desirable portion contained in the page document data as an output-suppressing area. However, Aoyagi suggests such a limitation by pointing out the benefits of suppressing unnecessary details. (Aoyagi, col. 1, lines 15-23.) Therefore, it would have been obvious to one of ordinary skill in the art to have output-subject setting means arbitrarily setting a desirable portion contained in the page document data as an output-suppressing area.

Further, given the benefits of using a mask taught by Aoyagi, noted above, it would have been obvious to one of ordinary skill in the art have the output control means outputting as a mask such data corresponding to the area set as the output-suppressing area by the output-subject setting means.

11. **Claims 6-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus et al.

Regarding **dependent claim 6**, Warmus et al. does not teach arbitrarily setting a desirable portion as a sequential number information adding area as an output condition when the designated data is outputted and adding the sequential number to every page to the area set as the sequential number information adding area. However, inasmuch as Warmus et al. teaches formatting a book (Warmus et al., col. 5, lines 18-20), and it was well known in the art that book pages advantageously contain page numbers, the recited claim limitations would have been obvious to one of ordinary skill in the art.

Regarding **dependent claim 7**, Warmus et al. teaches converting the document data formed by the application program into image page document data to be outputted. (Warmus et al., col. 5, lines 41-48.)



Further, Warmus et al. teaches SPOOL-storing into storage means a plurality of image page document data converted by the converting means. (Warmus et al., col. 5, lines 41-43.)

Regarding **dependent claim 8**, Warmus et al. teach converting documents into page document data so as to be printed out as to each page. (Warmus et al., col. 5, lines 46-48.)

Further, Warmus et al. inherently teach SPOOL-storing page document data in correspondence with the virtual print designating document inasmuch as Warmus et al. teach printing page document data as noted above and such storage would have been necessary in order to get the right content on the page for which it was intended.

Further, Warmus et al. do not explicitly teach designating desirable page document data as print-out-subject document data. However, it was well known in the art to designate some pages and not others for printing, and one of ordinary skill in the art would have recognized that this feature gave the user the flexibility to print only the content the user wished to see.

Therefore, it would have been obvious to one of ordinary skill in the art to designate desirable page document data as print-out-subject document data, and it further would have been obvious to set a print output condition when each of the designated print-out-subject document data was printed out because one of ordinary skill in the art would have recognized the benefits of being able to format the document for printing.

Further, Warmus et al. teach printing the document data (Warmus et al. col. 5, lines 43-48), and it would have been obvious to one of ordinary skill in the art to print the designated page document data in accordance with the print output condition because one of ordinary skill would have recognized that if the user had selected certain page document data, the user would want to print just that data according to whatever output conditions had been set.

Regarding **dependent claim 9**, Warmus et al. do not teach judging whether the corresponding page document data has been SPOOL-stored in the storage means when the virtual print is designated. However, one of ordinary skill in the art would have recognized the benefit of checking to see if the data that the user wanted to see had was in fact going to be printed, and therefore, it would have been obvious to one of ordinary skill in the art to judge whether the corresponding page document data has been SPOOL-stored in the storage means when the virtual print is designated.

Further, Warmus et al. do not disclose updating print data based on newly converted print data when it is judged that the corresponding page document data had been SPOOL-stored. However, one of ordinary skill in the art would have recognized that if the data the user wanted to see was available, then the user would have wanted to see it. Therefore, it would have been obvious to one of ordinary skill in the art to update print data based on newly converted print data when it is judged that the corresponding page document data had been SPOOL-stored.

Regarding **dependent claim 10**, Warmus et al. do not teach judging whether the corresponding page document data has been SPOOL-stored in the storage means when the virtual print is designated. However, one of ordinary skill in the art would have recognized the benefit of checking to see if the data that the user wanted to see had was in fact going to be printed, and therefore, it would have been obvious to one of ordinary skill in the art to judge whether the corresponding page document data has been SPOOL-stored in the storage means when the virtual print is designated.

Further, Warmus et al. do not teach SPOOL-storing corresponding page document data so that it can be judged that the corresponding page document data has been stored. However,

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one of ordinary skill in the art would have recognized that SPOOL storing page document data would have allowed users to print the data they wished to see, and therefore this limitation would have been obvious to one of ordinary skill in the art.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

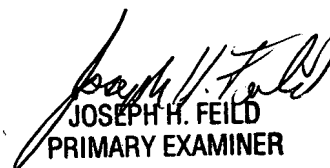
U.S. Patent Number	Name	Issue Date	File Date	
6,470,363 B1	Kanerva et al.	10/22/02	6/26/98	
6,338,076 B1	Hidding et al.	1/8/02	12/31/97	
6,247,011 B1	Jecha et al.	6/12/01	12/2/97	
5,995,723	Sperry et al.	11/30/99	11/18/97	
5,619,623	Takayanagi et al.	4/8/97	n/a	
5,459,826	Archibald	10/17/95	n/a	
5,379,373	Hayashi et al.	1/3/95	n/a	

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Bieneman whose telephone number is 703-305-8045. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

CAB  
April 30, 2003

  
JOSEPH H. FEILD  
PRIMARY EXAMINER